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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/664,894

09/22/2003

Nathalie Jager-Lezer

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ALEXANDRIA, VA 22314

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

NOTIFICATION DATE

DELIVERY MODE

03/31/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/664,894	Applicant(s) JAGER-LEZER, NATHALIE	
	Examiner JYOTHSNA A. VENKAT Ph. D	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43 and 45-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43,45-50,57-60,62,63 and 65-81 is/are rejected.
- 7) ☒ Claim(s) 51-56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment and remarks filed on 1/2/08. Claim 44 has been canceled as per applicants' amendment dated 1/2/08. Claims 43 and 45-81 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 102

Claims 43, 45-50, 57-60, 62-63 and 65-81 are rejected under 35 U.S.C. 102(e) as being anticipated by 6,491,931('931)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The filing date of the instant application is 9/22/03 since the provisional application is in French.

See examples for polyamide fibers, film forming polymer, wax, Cyclopentasiloxane. Wax or Cyclopentasiloxane can be the fatty phase. See pigments, which read on the claimed dyestuff. Water reads on hydrophilic medium.

See col.2, lines 5-15 for fibers having length and circle of diameter. The ranges claimed are within the ranges disclosed in the patent. See col.2, lines 22- 35 for various fibers, which include claimed polyamide fibers, polyurethane fibers, polyolefin fibers, acrylic polymers. Acetate fibers or, cotton fibers, or rayon fibers read on claimed non-aromatic polyamide fiber. The length and

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circle of diameter of fiber ranges claimed are within the ranges disclosed in the patent and Patent office is not equipped to measure the limitation of claims 44-45 and therefore patent also anticipates claims 43 and 45, absence of evidence to the contrary.

See col.2, lines 36-45 for fibers coated, see col.5, lines 61-65 for water and the concentration of the water, see col.5, last two lines through col.6 and col.7, lines 1-148 for lipophilic medium or and fatty phase and volatile oil. See col.5, lines 1-43 for wax, see col.3, lines 5 through col.4, lines 28 for the film forming polymer, see col.8, lines 9-31 for colorant or dye stuff and see the paragraph bridging col.s 8-9 for additives. See example 3, lines 30-33 for claimed method, which is "lengthening of the eyelashes". With respect to limitation claimed in claim 81, which is " provides lengthening of the eyelashes that is exactly in line with them", this is inherent since all the claimed limitations are met by the patent including lengthening of the eyelashes and therefore this property is inherent absence of evidence to the contrary.

Response to Arguments

Applicant's arguments filed 1/2/08 have been fully considered but they are not persuasive.

Applicants' argue:

"In the past, only flexible fibers have been used in mascara compositions. Such flexible fibers do not satisfy the rigidity requirements now set forth in claim 43. (See, page 6, lines 13-31 of the present specification, particularly lines 21-26, for further explanation of the claimed rigidity requirements). The present invention represents the first time that substantially rectilinear polymeric fibers have been used in a cosmetic composition, particularly a mascara composition. Thus, when the applied art refers to "fibers," it

refers to conventional, flexible fibers which do not satisfy the required definition of rigidity. That is, the applied art teaches or suggests only conventional compositions containing flexible fibers. Nowhere does any of the art upon which the rejections are based teach or suggest using the required rigid, substantially rectilinear polymeric fibers.

For example, Collin ('931) discloses polyamide fibers sold by P. Bonte (col. 2, lines 54-56; example 1). As Applicant will demonstrate shortly in a Rule 132 declaration, such polyamide fibers are flexible, not rigid and substantially rectilinear as required by the pending claims. Thus, Collin neither teaches nor suggests using the required rigid fibers."

In response to the above argument, applicants' have not submitted any evidence that patent '931 do not disclose claimed rigid substantially rectilinear polyamide fibers. Specification at page 6, ll 6-12 teaches that the rigid fibers and non rigid fibers can be differentiated using a microscope. PTO is not equipped to measure the fibers disclosed in the examples of patent '931, therefore patent '931 anticipates the instant claims.

Claims 43, 59-63, 65, 69-81 are rejected under 35 U.S.C. 102(e) as being anticipated by 6,726,917 ('917).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

The filing date of the instant application is 9/22/03 since the provisional application is in French.

See col.3, line 15 for polyamide fibers, see col.1, lines 38-for for oil, which reads on claimed fatty phase, see col.2, lines 10-68 for film forming polymer, see col.3, lines 10-48 for pigments, dyestuff and see example 2 for waxes and mixture of ethanol and water, which reads on claimed limitation of claims 60-62. Examples 1-2 have additives like surfactant, preservatives. See abstract for lengthening of the eyelashes. With respect to limitation claimed in claim 81, which is “ provides lengthening of the eyelashes that is exactly in line with them”, this is inherent since all the claimed limitations are met by the patent including lengthening of the eyelashes and therefore this property is inherent absence of evidence to the contrary.

Response to Arguments

Applicant's arguments filed 1/2/08 have been fully considered but they are not persuasive.

Applicants' argue:

“Kanji ('917) briefly discusses adding fibers to his compositions. However, nowhere does teach or suggest adding the required rigid, substantially rectilinear polymeric fibers to his compositions. Rather, Kanji's brief disclosure relating to fibers discloses that conventionally known fibers (that is, flexible fibers) could be added to his compositions.”

In response to the above argument, applicants' have not submitted evidence that the polyamide fibers of '917 are not rigid substantially rectilinear polyamide fibers claimed in the

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instant application. Specification at page 6, ll 6-12 teaches that the rigid fibers and non rigid fibers can be differentiated using a microscope. PTO is not equipped to measure the fibers disclosed in the patent '917, therefore patent '917 anticipates the instant claims.

Claim Rejections - 35 USC § 103

Claims 43, 45-50, and 57-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents '931 and 5,911,974 ('974).

Patent '931 as explained above. Patent '931 does not teach the limitation of claim 64, which is anhydrous compositions. However, patent '974 teaches cosmetic compositions and under example 2 teaches mascara composition without water. This composition is anhydrous composition and it has pigments, waxes. See col.5, lines 30-60, wherein patent teaches film former and also volatile solvent.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compositions of '931 by not using water since patent '974 teaches in the same mascara art compositions without water. This is prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 1/2/08 have been fully considered but they are not persuasive.

Applicants' argue:

"Brieva ('974), which is merely cited for its disclosure of an anhydrous composition, cannot compensate for Collin's and Kanji's deficiencies. None of the applied art would lead one skilled in the art to use the required rigid, substantially

rectilinear polymeric fibers in a cosmetic composition. The difference between flexible and rigid polymeric fibers is substantial. As noted in the present application at pages 6-7, the conceptual difference between the required rigid fibers and conventional flexible fibers can be analogized to the difference between uncooked spaghetti (rigid fiber) and cooked spaghetti (flexible fiber), and this physical difference in fibers results in significant differences in effect of the fibers, particularly with respect to lengthening of eyelashes: the rigidity of the claimed fibers allows for better arrangement of fibers in relationship to eyelashes, providing an enhanced lengthening effect, whereas the flexibility of conventional fibers results in more random arrangement of fibers, meaning that the lengthening effect is inferior. Nowhere does any of the applied art teach or suggest using the required substantially rectilinear polymeric fibers, or any benefits arising from such use."

In response to the above argument, specification teaches that the difference between rigid and flexible fibers can be differentiated using microscope. Applicants' have not submitted any evidence that the polyamide fibers of patent '931 are flexible. In response to this rejection if applicants submit evidence that the polyamide fibers of patent '931 are flexible, it is the position of the examiner that the claims are obvious since substituting one type of polyamide fiber for another type of polyamide fiber is obvious since both the fibers are functional equivalents and one of ordinary skill in the cosmetic art would use functional equivalent fiber of patent '931 expecting predictable results.

Double Patenting

Claims 43, 45-50, 59-63,65, 69-80 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7-21, 26-37, 41-56, 61-67, 70 and 72 of U.S. Patent No. 6,491,931. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap with the claimed fibers in the instant application. Patent and instant application is claiming the same film forming polymer (polyurethane) and wax. Patent and instant application is also claiming water, volatile oil and non-volatile oil. Patent and instant application is also claiming for fibers, fibers length and circle of diameter. The fibers are same and there is overlap with the fiber length and circle of diameter.

Response to Arguments

Applicant's arguments filed 1/2/08 have been fully considered but they are not persuasive.

Applicants' argue:

"The claims in Collin like the disclosures in these references neither teach nor suggest the required rigid polymeric fibers. In other words, the claims in these references would not lead one skilled in the art to the invention compositions containing the required rigid polymeric fibers. Rather, the claims in these references would only lead to conventional compositions containing flexible fibers."

In response to the above argument, applicants' did not submit evidence that the polyamide fibers are different to that claimed in the patent. In response to this rejection if applicants submit evidence that the polyamide fibers of patent '931 are flexible, it is the

position of the examiner that the claims are obvious since substituting one type of polyamide fiber for another type of polyamide fiber is obvious since both the fibers are functional equivalents and one of ordinary skill in the cosmetic art would use functional equivalent fiber of patent '931 expecting predictable results.

Claims 43, 45-50, 59-63, 65, 69-80 are directed to an invention not patentably distinct from claims 1, 7-21, 26-37, 41-56, 61-67, 70 and 72 of commonly assigned 6,491,931. Specifically, for the reasons sated above under obviousness-type double patenting rejection.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,491,931, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

This rejection is maintained.

Claims 51-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1615

